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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,739	03/23/2004	Harry N. Mason	G595A	2560

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EXAMINER	
MITCHELL, KATHERINE W	

ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/806,739	MASON, HARRY N.	
	Examiner	Art Unit	
	Katherine W. Mitchell	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *3/23/04* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chicckine USP 4221118 in view of Mason USP 4497186.

Re claim 1: Chicckine shows in Fig 2 a secure interchangeable earring for use with a pierced ear, the earring having a charm with a charm opening, and further comprising a body formed from a single integral piece of substantially uniform cross section, the body comprising a free end (11) for threading through the pierced ear (9) and sized to extend through the charm opening (6) (col 1 line 62 - col 2 line 3), a blocked end (3) to prevent dislodgement of the charm from the earring thereat; an apex portion (that portion in the ear hole), a vertical portion between the apex and the blocked end, and another middle portion (16) between the apex and the free end.

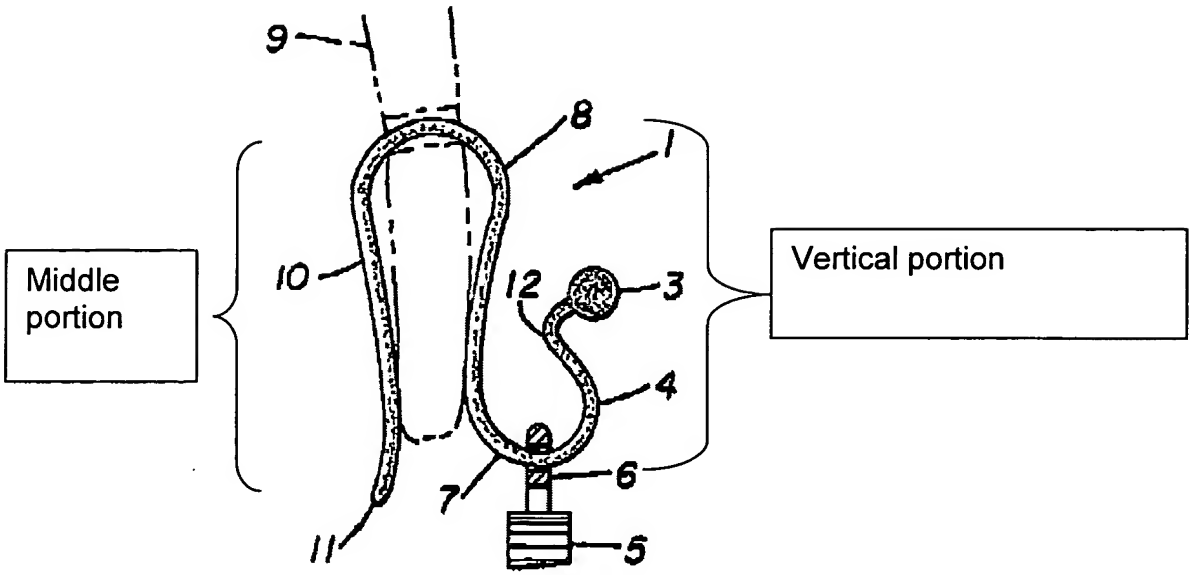

FIG. 2

Chicckine further teaches a charm (5) with a charm opening (6 - seen in cross section in the figures), and shows the body (1) sized to allow the charm to move fully from the free end to the blocked end, such that when the earring body is threaded onto the ear with the apex at the pierced hole, the charm is trapped between the blocked end and the pierced hole (shown in both figures). However, Chicckine lacks that the middle portion between the free end and the apex is spiraling. Mason teaches an earring with an apex and a spiraling section for additional decoration in the figures, especially Figs 2 and 8:

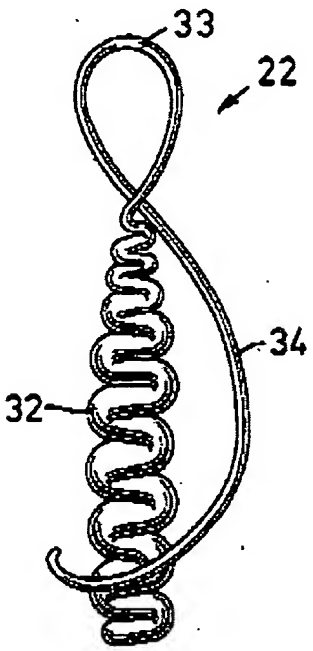

FIG.8

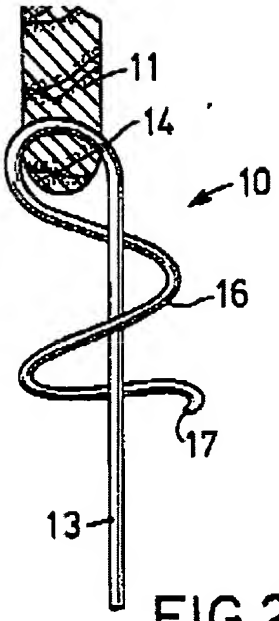

FIG.2

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Chicckine and Mason before him at the time the invention was made, to modify Chicckine as taught by Mason to include the decorative spiral of Mason, in order to obtain a more decorative and versatile earring, as Mason teaches in col 1 lines 60-63 that it is an advantage to have part of the attachment portion also serve as a decorative feature, (referring to the spiral).

Re claim 2: Chicckine teaches the earring further comprises a ball (3 in Fig 2) at the blocked end with a diameter larger than the earring charm (5) in the Figures and in col 1 lines 56-61.

Re claim 4: Chicckine teaches a curved bottom portion having a valley (7) and high point (12), the blocked end (3) located at the high point wherein the charm rests in the bottom portion of the valley when in place on the earring Fig 3)

Re claims 5-6: As discussed above, the earring is obvious over Chicckine in view of Mason. The method of use is intrinsically taught by the apparatus, as no other method would result in the arrangement in Fig 2, and the method is further discussed by Chicckine in col 1 lines 64-col 2 line 3. Charm installation would be as shown in Fig 2.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chicckine in view of Mason as applied above and further in view of Sutain, DES. 175867.

Re claim 3: Chicckine in view of Mason discloses the claimed invention except for the plurality of concentric circles at the blocked end which do not allow the charm to pass that portion of the body. As for decorative effect, Chicckine specifically teaches in col 1 lines 59-61 that the shape of the enlarged head can vary as long as it is aesthetically pleasing.

Sutain discloses an earring with a decorative end comprising the wire body bent to form concentric circles which would not allow a charm to pass (Fig 3). Therefore, it would have been would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made, to change the design of the blocked end, since applicant has not disclosed that concentric circles versus a ball end solves any stated problem or is for any particular purpose and it appears that the invention would equally well with the ball end.

Response to Arguments

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, jewelry is by its very nature decorative. The only claimed feature not taught by base reference Chicckine is the spiral feature between the free end and the apex. Chicckine does contemplate "various modifications to the curvature and length of the outer and inner portions". Obviously, if Chicckine taught all the elements as possibilities, Mason would not be needed. The motivation to combine is in Mason, as was pointed out on page 5 last paragraph in the first office action. Mason teaches in col 1 lines59-63 that it is desirable to have a simple, attractive, unusual earring and further have a "decorative portion, (spiral portion 16) which also serves at least as part of the attachment device for the earring." One of ordinary skill in the art at the time the invention was made would recognize that Chicckine's earring could potentially fall out of the ear, as there is a straight shot" between the apex and the free end. Mason's teaching of a decorative spiral that also helps serve as a part of the attachment device would be motivation to combine the decorative attachment device with Chicckine to serve a both a functional and decorative element, as specifically taught as desirable by Mason. The fact that there may be numerous other decorative portions that users may also prefer does not teach away from this.

It appears applicant also feels that Chicckine is balanced, and that Mason's spiral would cause it to become unbalanced. Inevitably, when enhancing the appearance of

jewelry, the changes would be done to ensure balance, just as applicant has changed the ball end to the circle end – this is not considered a separate invention, nor was applicant required to specify how the spiral, wire length, and wire weight were slightly changed so the alternate decoration could be employed. Examiner is not saying that Mason and Chiccine would be physically combined as is to form a new earring, but that the concept of having a spiral section to enhance looks and a more secure attachment in the ear would result.

Similarly, applicant argues that modifying Chicckine to include Sutain's teaching of concentric circles lacks motivation. One of ordinary skill in the art at the time the invention was made would recognize that Chicckine's earring could use multiple concentric circles as the blocking end feature, rather than a ball, by seeing the attractiveness and functionality of the concentric circles used by Sutain.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

6. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Note that examiner will have a new phone number after March 31, 2005: **(571)272-7069.**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell
Patent Examiner
Art Unit 3677

Kwm
3/25/2005